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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,709	08/19/2003	Gerhard Schmid	27392/26878	5110
4743	7590	01/22/2007	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			WILSON, JOHN J	
		ART UNIT		PAPER NUMBER
				3732
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	01/22/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/643,709	SCHMID ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 December 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12, 17-19 and 22 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12, 17-19 and 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-12, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (5899692) in view of Robinson et al (4807599) and Schlachter (4648838). Davis shows a handpiece 700, Figs. 7 and 8, elongated body 770, rear connection element 722 for supply lines, forward end light emission element 620, 630, column 5, lines 62-67 and column 7, lines 37-44, fluid outlet opening as shown. Davis shows the light emission element releasably connected to the forward end by threads, and as such, Davis does not show using a latching device. Robinson teaches using a latching device 22, which can spring inward and out to latch a light emission element 14. It would be obvious to one of ordinary skill in the art to modify Davis to include a latch means as shown by Robinson in order to make use of art known ways to best attach a light emission element to a handpiece. To locate the latch on the light emission element would be an obvious matter of choice in the reversal of the location of known elements to the skilled artisan. The above combination does not show a cannula having a light conductor extending from the lamp through the cannula to the light emission element. Schlachter shows a cannula 5 including a conductor 39 extending from a lamp 43 to a light emission element 42, Figs. 6-8. It would be obvious

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to one of ordinary skill in the art to modify the above combination to include a conductor for the cannula as shown by Schlachter in order to allow the choice of locating the lamp at the end on not as suggested by the different embodiments of Schlachter. Schlachter also teaches, for the embodiment of Fig. 2, that the light emission element 21 is releasably connected to the cannula. It would be further obvious to include a releasable connection as suggested by Schlachter in order to allow for parts to be changed out as is well known in the art.

Claims 3, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (5899692) in view of Robinson et al (4807599) and Nosov (6208788). Davis shows a handpiece 700, Figs. 7 and 8, elongated body 770, rear connection element 722 for supply lines, forward end light emission element 620, 630, column 5, lines 62-67 and column 7, lines 37-44, fluid outlet opening as shown. Davis shows the light emission element releasably connected to the forward end by threads, and as such, Davis does not show using a latching device. Robinson teaches using a latching device 22, which can spring inward and out to latch a light emission element 14. It would be obvious to one of ordinary skill in the art to modify Davis to include a latch means as shown by Robinson in order to make use of art known ways to best attach a light emission element to a handpiece. To locate the latch on the light emission element would be an obvious matter of choice in the reversal of the location of known elements to the skilled artisan. The above combination does not show a light emission element that can emit light from both the forward end and the side. Nosov shows light emission

elements 130, 140, Figs. 8 and 9, that teach the alternative of a light emission element 130 that emits light 90 from only the forward end and a light emission element 140 that emits light from both the forward end and the side, Fig. 9, in order to illuminate the desired area, column 11, lines 5-17. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a light emission element as shown by Nosov in order to better illuminate the entire desired area.

### ***Response to Arguments***

Applicant's arguments filed December 21, 2006 have been fully considered but they are not persuasive. Schlachter does show a conductor as detailed above. Nosov also teaches guiding light along a light transmission guide 124 to inside the mouth as Davis, and as such, the combination does not go against the teaching of Davis.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Melnyk et al (6325623) shows an emission element 30 that emits light from the side, Fig. 5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*John J. Wilson*  
**Primary Examiner**  
**Art Unit 3732**

jjw  
January 11, 2007